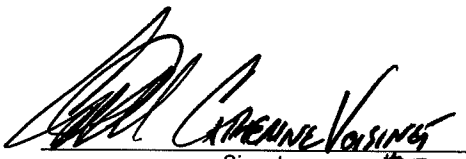


PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 1247-0464P	
	Application Number 09/995,652-Conf. #2631	Filed November 29, 2001	
	First Named Inventor Akitoshi KOJIMA et al.		
	Art Unit 3689	Examiner G. Araque	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>29,271</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> <p> Signature <u>#52,327</u></p> <p><u>Charles Gorenstein</u> Typed or printed name</p> <p><u>(703) 205-8000</u> Telephone number</p> <p><u>October 9, 2008</u> Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			

The Examiner has made clear errors in interpreting and applying the appropriate tests and applying the prior art in rejecting claims 14 under 35 U.S.C. § 102 as being anticipated by Trotta, Jr. (USP 5,595,264) (hereinafter "Trotta"); rejecting claims 1-13 under 35 U.S.C. § 103(a) as being unpatentable over Trotta in view of Garver (USP 7,114,656); and rejecting claims 15-16 under 35 U.S.C. § 103(a) as being unpatentable over Trotta in view of Garver and further in view of Murrah (USP 5,804,807) (hereinafter "Murrah").

**The Examiner has Failed to Establish *Prima Facie* Obviousness of Claims 1-13
by Failing to Provide References that, Either Explicitly or Inherently,
Teach or Suggest All of the Claim Elements**

The Examiner has made clear error in considering certain claim elements are taught by the combination of the teachings of Trotta in view of Garver.

In their previous reply, Applicants argued that the cited references fail to teach or suggest "comparing at the information-processing apparatus the commodity information which has already been relayed to the information-processing apparatus, with commodity information **which is sent from the portable terminal to a POS apparatus at a sales counter** and is then entered into the information-processing apparatus."

In response to this argument, the Examiner asserts in the final Official Action on page 11-12 as follows:

.. a comparison must be made since the file that is stored at the in-store computer must contain some type of identifier, which would identify the scanner with the customer, and when the scanner is placed back at the scanner terminal, another type of identifier must be transmitted from the scanner terminal to the in-store computer in order to compare that the two identifiers are the same in order to release the customer's payment card and the printing of the receipt of the total purchases."

However, the court in *In re Robertson* held "to establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The Examiner is asserting that it is inherent that the system compares at the information-processing apparatus the commodity information which has already been relayed to the information-processing apparatus, with commodity information which is sent from the portable terminal to a POS apparatus at a sales counter and is then entered into the information-processing apparatus. This assertion is supported by his statement that the

system must compare **identifier information** in order to confirm the transaction. However, it appears that the Examiner is misinterpreting the claim language.

Claim 1 clearly requires that the system **compares** at the information-processing apparatus **the commodity information** which has already been relayed to the information-processing apparatus, **with commodity information** which is sent from the portable terminal to a POS apparatus at a sales counter and is then entered into the information-processing apparatus.

By the Examiner's own statement, in considering the cited art, it is possible to perform the transaction in a different manner, namely by comparing **identifier information** that identifies the scanner used by the customer, and not commodity information as required by the claim. Thus, since it does not necessarily flow that the system compares at the information-processing apparatus the commodity information which has already been relayed to the information-processing apparatus, with commodity information which is sent from the portable terminal to a POS apparatus at a sales counter and this then entered into the information-processing apparatus, Applicants maintain that it is not inherent that the system must compare the commodity information as required by the claim.

Claim 1 recites a method that introduces a POS apparatus, and specifically recites, "comparing at the information-processing apparatus the commodity information which has already been relayed to the information-processing apparatus, with commodity information which is sent from the portable terminal to a POS apparatus at a sales counter and is then entered into the information-processing apparatus." The Examiner relies on col. 4, lines 30-40 to teach this claim element.

Trotta discloses at col. 4, lines 30-40 as follows:

Portable scanner 14 includes an optical scanner 23 which transmits the encoded bar code indicia information to a microprocessor 25, as diagrammatically shown in FIG. 4. Keypad buttons 24, 26, 28 also communicate the customer's selection to the microprocessor 25. Microprocessor 25 then transmits this received information to the in-store computer 20 by way of a transceiver 40 and transaction encoder/decoder 42. Computer 20 processes this information and returns the appropriate signal to microprocessor 25 such that the customer is correctly informed of their shopping purchase.

In addition, Trotta discloses the in-store computer relating the item selected for purchase to an inventory retrieval system (col. 5, lines 35-38). However, Trotta fails to teach or suggest communication of commodity information that is scanned by the user to in-store computer 20. As such, Trotta fails to teach or suggest "comparing at the information-processing apparatus the commodity information which has already been relayed

to the information-processing apparatus, with commodity information **which is sent from the portable terminal to a POS apparatus at a sales counter** and is then entered into the information-processing apparatus,” as suggested by the Examiner.

Applicants respectfully submit that Garver fails to cure the deficiencies of the teachings of Trotta.

As neither Trotta nor Garver teach or suggest all of the claim elements, Applicants respectfully submit that claim 1 is not obvious over the teachings of the cited references. It is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 2 and 15 are allowable for the reasons set forth above with regard to claim 1 at least based on their dependency on claim 1.

Regarding claim 3, as noted above, Trotta fails to teach or suggest the POS apparatus communicating with the information processing apparatus in the manner claimed. Further, Garver fails to cure the deficiencies of the teachings of Trotta. Thus, for the reasons set forth above, Applicants respectfully submit that claim 3 is patentable over the references as cited. It is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 4-13 and 16 are allowable for the reasons set forth above with regard to claim 3 at least based upon their dependency on claim 3.

**The Examiner has Failed to Establish *Prima Facie* Anticipation of Claim 14
by Failing to Provide References that Teach or Suggest All of the Claim Elements**

The Examiner has made clear error in considering certain claim elements are directed to “intended use” and therefore not afforded patentable weight.

1. The claim elements are not directed to “intended use” as asserted by the Examiner.

In their previous reply, Applicants argued that Trotta fails to anticipate claim 14 as Trotta fails to teach or suggest customer identifying information written onto another wireless tag. In response to this argument, the Examiner asserted that he is not affording patentable weight to the type of information stored on the wireless tag. He asserts that this claim element is a recitation of intended use and that the structure of the claim is the same as the structure recited in Trotta. The Examiner concludes that since the structure is Trotta is capable of performing the intended use, then the teachings are sufficient to teach the claim element. Applicants respectfully disagree with the Examiner’s interpretation of “intended use.”

The Examiner's form paragraph used in response to Applicants' arguments is found under the heading "Answering Asserted Advantages" in the MPEP. In contrast, the arguments presented in our previous reply recite elements that are explicitly recited in the claims and are not asserted advantages as a result of the claimed invention. As such, the Examiner is clearly misinterpreting the rules for claim interpretation.

It is well established that the Examiner must afford patentable weight to all of the elements recited in claim. Applicants submit that the Examiner's failure to afford proper patentable weight to the functionality of the tag reader, as clearly recited in the body of the claim is wholly improper.

2. The claim elements are not directed to "non-functional descriptive material" as asserted by the Examiner.

The Examiner further asserts that customer identifying information amounts to non-functional descriptive material. However, the claims, when read in light of the specification, provide for customer identifying information read from a wireless tag. The information that is read from the tag is then transmitted together with the commodity information to an information-processing apparatus. Applicants submit that the customer identifying information is not merely non-functional descriptive material.

3. The cited reference fails to teach or suggest all of the claim elements.

Claim 14 recites a portable terminal comprising a tag reader for reading via radio waves commodity information written onto a wireless tag located on a sample commodity remote from a checkout area **and customer identifying information written onto another wireless tag**; a storage for accumulating and storing commodity information that has been read by the tag reader; a wireless communication device for transmitting commodity information to an information-processing apparatus via radio waves at the same time that the commodity information is stored in the storage, **and transmitting the customer identifying information to the information-processing apparatus via radio waves**; and a display for displaying the commodity information that has been read out.

In contrast, the disclosure of Trotta is directed to a system and method for automated shopping. At col. 6, lines 20-32, Trotta discloses as follows:

In a further preferred embodiment of the invention, the payment card 10 is used for identification of the customer during his shopping and the total purchase price of the items is deducted from the customer's account at completion of the shopping. As the selected items are scanned, the in-store computer 20 merely records the purchase to the customer's account and the receipt. Then, once the customer has

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finished shopping and returned the scanner 14 to its holder 16, the display panel 22 will ask the customer to confirm the final purchase total by pressing the green button 24. Once actuated, the computer 20 debits the total purchase to the customer's payment card 10, and a receipt is issued to the customer.

As can be seen from the above disclosure, Trotta discloses that a payment card 10 is used for identification of a customer, the payment card 10 being inserted into a slot 12 of a scanner terminal 18. In the disclosure of Trotta, customer identifying information of the payment card 10 is neither read using a portable scanner 14 via radio waves, nor transmitted to an information processing apparatus via radio waves.

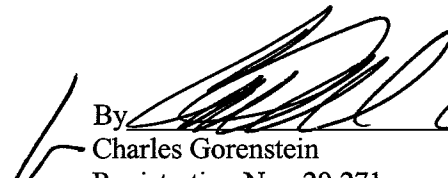
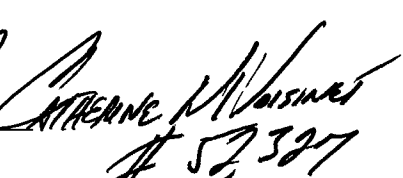
As Trotta fails to teach or suggest all of the claim elements, Applicants respectfully submit that claim 14 is not anticipated by, and thus allowable over, the teachings of Trotta.

Conclusion

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: October 9, 2008

Respectfully submitted,

By  
Charles Gorenstein
Registration No.: 29,271
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant